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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,533	04/20/2006	Muneki Nakao	03500.102835.	3836
5514 7590 11/02/2009 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER				
SANTIAGO, LUIS F				
ART UNIT		PAPER NUMBER		
3624				
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11/02/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/576,533

**Applicant(s)**

NAKAO ET AL.

**Examiner**

LUIS SANTIAGO

**Art Unit**

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2, 4, 6, 8, 10-13 is/are pending in the application.  
4a) Of the above claim(s) None is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 2, 4, 6, 8, 10-13 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 20 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date 6/20/2007  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is in response to applicant's submission filed on April 20, 2006, wherein claims 2, 4, 6, 8, 10 - 13 are pending and examined on the merits.

#### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4, 10 and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding Claims 4, 10 and 11, Claims 4, 10 and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 4, 10 and 11 fail to meet the above requirements because they are not tied to another statutory class of invention.

Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraph of 35 U.S.C.102 that form the basis for the rejections under this section made in this office action.

A person shall be entitled to a patent unless –

(e) the invention was described in:

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 2, 4, 6, 8, 10 - 13 are rejected under 35 U.S.C. 102(b) as being anticipated by *Mastering Microsoft Office 97* (Hereinafter referred to as *Moseley*).

With respect to **claim 2**:

*Moseley* teaches an information apparatus comprising a control unit which, when a notice "scheduled" date comes in a power-OFF status and then the apparatus is powered ON, "provides

a notification" of "schedule" "as to which a reminder has not yet been given and for" which "an indicated notice time" is not "more than" a predetermined time in the past before a current date, as a reminder, and does not notify "provide any reminder as to a" "schedule" as to which "an indicated notice time is more than" the predetermined time in the past before the current date. The user or customer can create appointments or meeting and specify the start and end time, the date and time and can indicate in advance you want to be reminded. (See Moseley, Page 787).

With respect to **claim 4**:

Moseley teaches a method of controlling an information apparatus comprising the steps of:

when a notice "scheduled" date comes in a power-OFF status and then the power supply is powered ON, "providing a notification of" "schedule" "as to which no reminder has yet been given, and as to" which "an indicated notice time is" not "more than" a predetermined time before the notice "scheduled" date, as a reminder. The user can specify a start date in the start combo box. When a due date is specify, the user can indicate the length of time until the due date (See Moseley, Page 793); and

when the notice "scheduled" date comes in the power-OFF status and then the power supply is powered ON, "not providing a notification of" "schedule" as to which "an indicated notice time is more than" the predetermined time before the notice "scheduled". The start date is usually the day that are creating the appointment, but the user can change the date and duration it if necessary. (See Moseley, Page 789).

With respect to **claim 6**:

Moseley teaches a program which causes a computer to execute: a notification procedure of, when a notice "scheduled" date comes in a power-OFF status and then the power supply is powered ON, "providing a notification of" "schedule" "as to which no reminder has been provided, and as to" which "an indicated notice time is" not "more than" a predetermined time in the past, as a reminder, The user or customer can create appointments or meeting and specify the start and end time, the date and time and can indicate in advance you want to be reminded. (See Moseley, Page 787); and

an un notification procedure of, when the notice "scheduled" date comes in the power-OFF status and then the power supply is powered ON, not "providing a notification of the" "schedule" as to which "the indicated notice time is more than" the predetermined time in the past. The start date is usually the day that are creating the appointment, but the user can change the date and duration if necessary. (See Moseley, Page 789).

Note that Outlook is a computer program, and therefore must operate on some medium such as a hard drive, mobile device, and have logic in the form of software code.

With respect to **claim 8**:

Moseley teaches an information apparatus which is directed for "providing a notification" of an un notified schedule whose notice "scheduled" date registered in the apparatus comes "while the apparatus" is in a power-OFF status, wherein an un notified schedule which is included in a set of a predetermined number of schedules "that are most recent" before a current date set in the information apparatus is "communicated" as a reminders when the apparatus is powered ON, Outlook is powerful information manager, have the capabilities as a mail manager,

time scheduler, etc. In the mail folder the user can get to the user Inbox, Sent Items, outbox, etc. (See Moseley, Pages 755- 759); and

an un notified schedule which is not included in that set, is not communicated as a reminder. The user can select or unselect the checkbox of reminder. (See Moseley, Fig. 35.5, page 787).

With respect to **claims 10 and 12**:

Moseley teaches a method of notifying a schedule as to which “no reminder has been given” due to stop of a communication function even when a notice “scheduled” date “has arrived” in the function of notifying “user of” a schedule booked in an information apparatus, The user can create the event or new appointment specify start and times also choose start and end dates. (See Moseley, Pages 790 - 792).

wherein when the notification function is started thereafter, schedule “as to which no reminder has been given and” which is included in “a set of” a predetermined number of schedules “that are most recent” before a current date set in the information apparatus, is “communicated” as a reminder, The application of Outlook let viewing of recurring appointments, grouped by categories. (See Moseley, Page 791, Fig 35.9), and

schedule which is not included in “that set”, is not “communicated” as a reminder. The events are distinguished from normal appointments; the calendar show events at the top of each day. (See Moseley, Page 792).

With respect to **claims 11 and 13**:

Moseley teaches a notice method according to claim 10, wherein a stop status of a notification function is a status where an information apparatus is powered OFF, and the

notification function is started when the information apparatus is powered ON. The user can add function to the message dialog box, example the delivery options the customer or user can select "does not delivery before" and when the event or appointments "expire". (See Moseley, Page 816, Fig 37.6)

### *Conclusion*

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed Luis Santiago whose telephone number is (571) 270-5391. The examiner can normally be reached Monday to Friday from 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on (571) 272-6704. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) System. Status Information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.



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/LS/

October 23, 2009

/Bradley B Bayat/

Supervisory Patent Examiner, Art Unit 3624